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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,534	09/25/2003	Jinru Bian	03010US	5465
7590	05/09/2005		EXAMINER	
Rodel Holdings, Inc. Suite 1300 1105 North Market Street Wilmington, DE 19899				MARCHESSI, MICHAEL A
		ART UNIT		PAPER NUMBER
		1755		

DATE MAILED: 05/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

1.5

Office Action Summary	Application No.	Applicant(s)	
	10/670,534	BIAN ET AL.	
	Examiner	Art Unit	
	Michael A. Marcheschi	1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 09 February 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 5-10 and 12 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-4 and 11 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date 2/4/05, 3/21/05.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Applicant's election with traverse of group I, claims 1-4 in the reply filed on 2/9/05 is acknowledged. The traversal is on the ground(s) that applicants have placed the abrasive limitation in the group II claims and the solution particulars of the group I claims into the group III claims (method claims).

Although the claims have been amended in the manner defined above, The group II claims (5-8) when compared to the group I claims are unrelated, as previously defined because the inventions are not disclosed as capable of use together and they have different modes of operation, different functions, and different effects (MPEP § 806.04, MPEP § 808.01). In other words, the group II invention is an independent solution because it is completely different from the group I invention in term of the amount of components and components themselves and the Group II invention does not require the pH and selectivity of the group I invention. Applicants have not presented any clear and convincing evidence to overcome the previous restriction and thus this requirement is made final.

With respect to the group II invention, the solution particulars of the group I claims into the group III claims (method claims 9-10), these claims will be rejoined once the invention of the group I claims is found allowable assuming that all the solution particulars of the group I claims are incorporated into the group III claims (method claims).

In response to this requirement, applicants are requested to cancel the group II claims.

New claim 12 which is dependent on a withdrawn claim must also be canceled since the above restriction is made final.

In the following claims, CDO means carbon doped oxide (see section [0063] of the specification).

Claims 1-4 are directed to an invention not patentably distinct from claim 4 of commonly assigned publication number 2005/0031789. Specifically, the copending claims claim a composition which comprises 0.1-10% of an oxidizing agent and 0.0025-6% of an inhibitor, abrasive particle and 0.001-3% of an organic ammonium salt. Although the claims do not define the specific oxidizing agent and inhibitor (i.e. imidazole), the claimed materials are obvious because **A generic disclosure renders a claimed species prima facie obvious. Ex parte George 21 USPQ 2d 1057, 1060 (BPAI 1991); In re Woodruff 16 USPQ 2d 1934; Merk & Co. v. Biocraft Lab. Inc. 10 USPQ 2d 1843 (Fed. Cir. 1983); In re Susi 169 USPQ 423 (CCPA 1971).** The claimed materials are known oxidizers and inhibitors. In addition, one can look to the specification for the meaning of a term and the specification defines oxidizers and inhibitors as meaning the claimed materials. With respect to the selectivity, it is the examiners position that although the reference fails to literally define this, this composition of the reference is expected to yield this property because the composition is the same (contains the same materials in the same amounts) and the same composition is expected to provide the same results absent evidence to the contrary.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302).

Commonly assigned publication number 2005/0031789, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter. A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Claims 1-4 and 11 are rejected under 35 U.S.C. 103(a) as being obvious over Liu et al. (publication number 2005/0031789)

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the

application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

The reference teaches in sections [0020]-[0036], a polishing composition which comprises 0.1-10% of an oxidizing agent and 0.0025-6% of an inhibitor (imidazole), 0-25% abrasives and 0.001-3% of an organic ammonium salt. The claimed amounts and components are clearly encompassed by the reference. With respect to the selectivity, it is the examiners position that although the reference fails to literally define this, this composition of the reference is expected to yield this property because the composition is the same (contains the same materials in the same amounts) and the same composition is expected to provide the same results absent evidence to the contrary.

Claims 1-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of copending Application No. 10/634,437 (publication number 2005/0031789). Although the conflicting claims are not identical, they are not patentably distinct from each other because the reduction to practice of the composition of the copending claims would render obvious the instant claims. Specifically, the copending claims claim a composition which comprises 0.1-10% of an oxidizing agent and

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0.0025-6% of an inhibitor, abrasive particle and 0.001-3% of an organic ammonium salt.

Although the claims do not define the specific oxidizing agent and inhibitor (i.e. imidazole), the claimed materials are obvious because **A generic disclosure renders a claimed species prima facie obvious. *Ex parte George* 21 USPQ 2d 1057, 1060 (BPAI 1991); *In re Woodruff* 16 USPQ 2d 1934; *Merk & Co. v. Biocraft Lab. Inc.* 10 USPQ 2d 1843 (Fed. Cir. 1983); *In re Susi* 169 USPQ 423 (CCPA 1971).** The claimed materials are known oxidizers and inhibitors. In addition, one can look to the specification for the meaning of a term and the specification defines oxidizers and inhibitors as meaning the claimed materials. With respect to the selectivity, it is the examiners position that although the reference fails to literally define this, this composition of the reference is expected to yield this property because the composition is the same (contains the same materials in the same amounts) and the same composition is expected to provide the same results absent evidence to the contrary.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being obvious over EP 1,229,093.

The reference teaches in the abstract and sections [0016]-[0039], a polishing composition having a pH within the claimed range which comprises hydrogen peroxide, an abrasive, an organic ammonium salt and imidazole. The amounts for the components are defined.

The reference clearly teaches a composition which contains all of the claimed components and although the reference does not literally define the amounts in terms of weight percent, it is the examiners position that when the reference amounts are converted to weight

percent they will encompass the claimed range. Although the reference does not literally define the selectivity, this aspect is obvious because it is the examiners position the composition of the reference is expected to yield this property because the composition is the same (contains the same materials in the same amounts) and the same composition is expected to provide the same results absent evidence to the contrary. In addition, the reference teaches that tantalum nitride and CDO can be polished.

Applicant's arguments with respect to claims 1-4 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Although the EP reference above was submitted on an IDS with the required certification, this action can still be made final because applicants amendment necessitated a new grounds of rejection (see MPEP 609 (a) ii) on page 600-132 of the May 2004 edition).

In view of the teachings as set forth above, it is the examiners position that the references reasonably teach or suggest the limitations of the rejected claims.

A reference is good not only for what it teaches but also for what one of ordinary skill might reasonably infer from the teachings. *In re Opprecht* 12 USPQ 2d 1235, 1236 (CAFC 1989); *In re Bode* USPQ 12; *In re Lamberti* 192 USPQ 278; *In re Bozek* 163 USPQ 545, 549 (CCPA 1969); *In re Van Mater* 144 USPQ 421; *In re Jacoby* 135 USPQ 317; *In re LeGrice* 133 USPQ 365; *In re Preda* 159 USPQ 342 (CCPA 1968). In addition, "A reference can be used for all it realistically teaches and is not limited to the disclosure in its preferred embodiments" See *In re Van Marter*, 144 USPQ 421.

A generic disclosure renders a claimed species prima facie obvious. *Ex parte George* 21 USPQ 2d 1057, 1060 (BPAI 1991); *In re Woodruff* 16 USPQ 2d 1934; *Merk & Co. v. Biocraft Lab. Inc.* 10 USPQ 2d 1843 (Fed. Cir. 1983); *In re Susi* 169 USPQ 423 (CCPA 1971).

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a prima facie case of obviousness, see *In re Malagari*, 182 U.S.P.Q. 549; *In re Wertheim* 191 USPQ 90 (CCPA 1976)≡.

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Evidence of unexpected results must be clear and convincing. *In re Lohr* 137 USPQ 548.

Evidence of unexpected results must be commensurate in scope with the subject matter claimed.

In re Linder 173 USPQ 356.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

5/05

MM

Michael A. Marcheschi
Primary Examiner
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